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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,485	05/10/1999	STEPHEN CHIN	LNC314/97	4894

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/307,485

Applicant(s)

CHIN, STEPHEN

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-15 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-15 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. Applicant's arguments, see paper #22 appeal brief, filed February 10 2004, with respect to the rejection(s) of claim(s) 5-15 and 27 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of paper #22.

### ***Election/Restrictions***

2. In response to the Restriction Requirement mailed June 2, 2003, Applicant elected Group II, claims 5-15 and 27, with traverse.

3. Applicant's election with traverse of Group II in Paper No. 17 is acknowledged. The traversal is on the ground(s) that "the restricted claim are allowable" and "the invention are distinct if it can be shown that a combination as claimed; (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobvious), and (B) the sub combination can be shown to have utility either by itself or in other different relations". This is not found persuasive because the combination as claimed does not require the particular of the subcombination as claimed such as awarding the bidders for payments by not using money orders. The subcombination has separate utility such as paying bills online by not participating in an auction event.

4. Claim 2-4, 16-26, of Group I, therefore are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 17.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subjectmatter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 5 recites the limitation "printing in an automated manner a money order that is backed by someone other than the buyer from said money order system upon receipt of said transmitted information from said buyer". The specification lacks written description in the description of how is the money order being printed in an "automated manner".

8. Dependent claims are rejected for incorporating the defects from the parent claim by dependency.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novogrod (US 6,367,693) in view of Shkedy (US 6,260,024).

Novogrod discloses a method of purchasing a money order from a money order system via the Internet substantially claimed including the steps of:

- contacting said an Internet site for said money order system via the Internet by said buyer with a computing device (abstract);
- transmitting information (40) to said money order system via the Internet;
- printing a money order from said money order system upon receipt of said transmitted information from said buyer (106; fig.15);
- providing a hyper-link in the auction site to the money order system site (via Internet);
- generating a message to at least one of said buyer or seller stating that said money order has been sent to said seller (col.21, line28-col.22, line 55);

However, Novogrod fails to disclose a payment method used by an online auction site to settle a sales transaction with money order system (i.e. to purchase said money order for said sale of said goods won during the auction process with the Internet auction site, said information including at least said buyer's identification, an identification of said seller and a financial amount for the money order, wherein said financial amount is related to the bid; and transmitting credit card information associated with said buyer to said money order system Internet site; said money order is backed by a third party) and a physical delivery of the money order.

Shkedy discloses a payment system and method for settling buyer/seller transactions from an auction site by using money order (col.6, line 29-col.8, line 40) and physically delivering a money order (postal mail).

It is notoriously well known in e-commerce to purchase items online in an auction site and settling payments using negotiable instruments such as bank checks, money orders, traveler's checks, and credit cards.

In view of Shkedy, it would have been obvious to a person having ordinary skill in the art to use Shkedy's settlement system and method to purchase a money order for the sale of goods during the auction process with the Internet auction site, the information including at least a buyer's identification, an identification of a seller and a financial amount for the money order, and the financial amount is related to the bid, and transmitting credit card information associated with the buyer, and the money order is backed by a third party for the purpose of creating a binding contract, minimizing disputes, maintaining bill collection, authenticating buyers from a

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trusted negotiable instrument, maintaining the anonymity of the buyer. Furthermore, it would have been obvious to use Novogrod's money order dispensing system to facilitate the online auction purchases of Shkedy's for a more secure business transaction with a higher degree of confidence of the negotiable instrument so that the seller can cash the money for the value stated on the instrument.

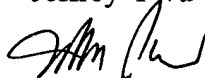
*Response to Arguments*

11. Applicant's arguments with respect to claims 5-15 and 27 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 703 308-7835. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Souh can be reached on 703 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey Pwu



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JEFFREY PWU  
PRIMARY EXAMINER